

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT C. HARRIS

Appeal 2007-1353
Application 09/682,853
Technology Center 2100

Decided: June 18, 2007

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the final rejection of claims 1-3, 5-10, 17-21, and 23. Claims 4, 11-16, and 22 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention generally relates to a method of obtaining specific kinds of information from the Internet using clients such as a hand

held device. According to Appellant, requests for information are sent to a service computer which reformats the requests into a specific form required by the server, sends the request, receives the response, and reformats that response (Specification 2). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method, comprising:

sending a request for information from an interactive device to a first recipient;

sending a request from said first recipient to said interactive device, requesting said interactive device to identify more information about a specific query to be made to said request to query a publicly accessible source of information;

at said first recipient, using information from said request to query a publicly accessible source of information;

receiving results from querying said source of information;

reformatting said results into a new form; and

sending said results in said new form to said interactive device.

The Examiner relies on the following prior art references:

Steele	US 2002/0046084 A1	April 18, 2002 (filed Oct. 8, 1999)
Chen	US 2002/0177453 A1	Nov. 28, 2002 (filed May 10, 2001)
Rajan	US 6,633,910 B1	Oct. 14, 2003 (filed Dec. 14, 1999)

The rejections as presented by the Examiner are as follows:

1. Claims 1-3, 5-8, 17-21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen and Steele.
2. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen and Steele and further in view of Rajan¹.
3. Claims 9-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen and Rajan.

Rather than reiterate the opposing arguments, reference is made to the Briefs and the Answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered (37 C.F.R. § 41.37(c)(1)(vii)).

We affirm.

ISSUE

To show that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) (2004), Appellant's arguments focus on the claimed limitation related to "requesting said interactive device to identify more information about a specific query to be made to said request to query a publicly accessible source of information" (Br. 9). Appellant argues that one of ordinary skill in the art would not have combined the references and even

¹ The rejection of claim 8 over the combination of Chen, Steele and Rajan, as modified by the Examiner (Answer 7-9) appears to be the correct rejection since the base claim 1 is rejected over the combination of Chen and Steele.

if the combination were made, the request in Steele is not requesting clarification of the query. Specifically, the issue is:

whether the prior art teachings disclose or suggest the claimed subject matter including requesting clarification of the query to a publicly accessible source of information.

FINDINGS OF FACT

Appellant's claim 1 requires the step of requesting the interactive device to identify more information about a specific query. The information about a query is then used to query a publicly accessible source of information. There is nothing in the claim that limits the information about a query to any particular type of information.

Chen relates to a mobile device server for providing a gateway allowing the user of the mobile device to use a variety of protocols and access networks to relay information and obtain data from a wide range of resources (§ 0008).

Chen discloses that a mobile device, in order to send a request for information on stock prices to a messaging client, communicates with a mobile device server which receives the request and formats the request (§ 0011).

Chen further discloses that the mobile device server is capable of supporting new devices with devlets (§ 0060) which can require additional information for telling the mobile device server how and when to access this device (§ 0076). Therefore, more information about the query includes the time period in which the user may be accessed.

Steele discloses a multimedia system for personalized information services, access to data, and navigation services in addition to audio broadcasts in a vehicle through the use of a wireless Internet connection to an Internet gateway network (§ 0017).

Steele provides services or products to an end user in exchange for receiving advertisements (§ 0110). The transmission of advertisements is triggered by a message received by the system from the multimedia device. This message could be sent, among other ways, manually by the user interacting with the multimedia device 20 or other devices communicating with the system (§ 0111). Therefore, the information contained in the advertisement is sent to the user following a request by the user.

As depicted in Figures 9-11, Steele provides for obtaining additional information from the user if needed to complete the transmission of the advertisement to the user (§ 0130). Thus, following the request from the system for additional user information, the user may send such information to the system which in turn, is used for obtaining the requested information from the vendor and forwarding it to the user (§ 0131).

PRINCIPLES OF LAW

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled

in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Thus, what is required in the analysis is “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” and not “precise teachings directed to the specific subject matter of the challenged claim” when inferences and creative steps that a person of ordinary skill in the art would employ are taken into consideration. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007); *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

ANALYSIS

Based on our findings related to the teachings of Chen and Steele, we disagree with Appellant that Chen may not be properly combined with Steele since Chen attempts to figure out the additional information it needs based on the user profile rather than sending an additional message (Br. 6-7). In fact the server in Chen does receive additional information such as how and when to access the mobile device.

We also disagree with Appellant (Br. 7-8) that the references are non-analogous since, as determined above, Steele relates to a multimedia device which similar to Chen provides the user with, not only broadcast programs, but information and data obtained from Internet. Therefore, in combining the teachings of Chen with Steele, one of ordinary skill in the art would have found the benefits of obtaining more information about the requested data to achieve targeted advertisement in Steele equally useful in the information delivery of Chen.

Appellant's arguments related to Steele's request for additional information not being about a specific query are also unconvincing since Steele does teach obtaining additional information about the query by the server before the advertisement is sent to the user. Therefore, as argued by the Examiner (Answer 16), Appellant's view of Steele is too limiting and does not include what one of ordinary skill in the art would have inferred from the reference.

The Examiner's use of the term "can" in describing how the references are combined notwithstanding, we find that the Examiner has properly combined Chen and Steele based on what they teach and suggest to one of ordinary skill in the art. In fact, the additional information used in preparing the targeted advertisement in Steele would have motivated the ordinary skilled artisan to modify the information delivery of Chen to further customize the received results from the Internet.

CONCLUSION

In view of the analysis above, we find that the Examiner's rationale and reasoning presented in support of the rejection are convincing of the obviousness of claim. We also note that Appellant has not presented any substantive arguments directed separately to the patentability of independent claims 17 and 21 as well as dependent claims 2, 3, 5-7, and 17-23. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d at 590, 18 USPQ2d at 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the

Examiner's 35 U.S.C. § 103 rejection of these claims as being unpatentable over the Chen in view of Steele.

With respect to the rejection of claim 8, Appellant relies on the same arguments presented for claim 1 and discussed above (Br. 12) while for the rejection of claims 9 and 10, Appellant argues that Rajan's template are scripted (Br. 13). Based on our findings related to the template and the HTML format taught by Rajan, we find the Examiner's position to be reasonable and sufficient for one of ordinary skill in the art to combine the references to arrive at the claimed invention. Accordingly, we sustain the 35 U.S.C. § 103 rejection of claim 8 over Chen, Steele and Rajan and of claims 9 and 10 over Chen and Rajan.

NEW GROUND OF REJECTION

The following new rejection for claims 1-3 and 5-8 is entered under the provisions of 37 C.F.R. § 41.50 (b).

Claim 1 is rejected under the second paragraph of 35 U.S.C. § 112 for being indefinite. The claimed term "to identify more information about a specific query to be made to said request" refers to a request whereas the claim includes two different requests, one sent from an interactive device to a first recipient and the other sent by the first recipient to the interactive device.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

DECISION

The decision of the Examiner rejecting claims 1-3, 5-10, 17-21, and 23 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED – 37 C.F.R. § 41.50 (b)

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